



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,736	10/09/2001	Michael Brian Bass	A-548A	3570

7590 02/17/2004

Nancy A. Oleski
U. S. Patent Operations/ NAO
AMGEN, INC.
One Amgen Center Drive, Dept. 4300, M/S 27-4-A
Thousand Oaks, CA 91320-1799

EXAMINER

HELMS, LARRY RONALD

ART UNIT	PAPER NUMBER
----------	--------------

1642

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/976,736	BASS ET AL.	
	Examiner	Art Unit	
	Larry R. Helms	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 2, 3, 6, 7, 8, 11-13, 16, in part, drawn to DNA comprising SEQ ID NO:1 and its complement, vectors, and cells comprising such and method of producing such, classified in class 536, subclass 23.1.
 - II. Claims 1, 2, 3, 6, 7, 8, 11-13, 16, in part, drawn to DNA comprising SEQ ID NO:3 and DNA hybridizing to such and its complement, vectors, and cells comprising such and method of producing such, classified in class 536, subclass 23.1.
 - III. Claims 1, 2, 3, 6, 7, 8, 11-13, 16, in part, drawn to DNA comprising SEQ ID NO:4 and DNA hybridizing to such and its complement, vectors, and cells comprising such and method of producing such, classified in class 536, subclass 23.1.
 - IV. Claims 1, 2, 3, 6, 7, 8, 11-13, 16, in part, drawn to DNA comprising SEQ ID NO:5 and DNA hybridizing to such and its complement, vectors, and cells comprising such and method of producing such, classified in class 536, subclass 23.1.
 - V. Claims 1, 2, 3, 6, 7, 8, 11-13, 16, in part, drawn to DNA comprising SEQ ID NO:6 and DNA hybridizing to such and its complement, vectors, and cells comprising such and method of producing such, classified in class 536, subclass 23.1.

- VI. Claims 1, 2, 3, 6, 7, 8, 11-13, 16, in part, drawn to DNA comprising SEQ ID NO:7 and DNA hybridizing to such and its complement, vectors, and cells comprising such and method of producing such, classified in class 536, subclass 23.1.
- VII. Claims 1, 2, 3, 6, 7, 8, 11-13, 16, in part, drawn to DNA comprising SEQ ID NO:75 and DNA hybridizing to such and its complement, vectors, and cells comprising such and method of producing such, classified in class 536, subclass 23.1.
- VIII. Claims 1, 2, 3, 6, 7, 8, 11-13, 16, in part, drawn to DNA comprising SEQ ID NO:76 and DNA hybridizing to such and its complement, vectors, and cells comprising such and method of producing such, classified in class 536, subclass 23.1.
- IX. Claims 1, 2, 3, 6, 7, 8, 11-13, 16, in part, drawn to DNA comprising SEQ ID NO:77 and its complement, vectors, and cells comprising such and method of producing such, classified in class 536, subclass 23.1.
- X. Claims 1, 2, 3, 6, 7, 8, 11-13, 16, in part, drawn to DNA comprising SEQ ID NO:76 and DNA hybridizing to such and its complement, vectors, and cells comprising such and method of producing such, classified in class 536, subclass 23.1.
- XI. Claims 1, 2, 4, 6, 7, 9, 11-12, 14, 16-17, in part, drawn to DNA encoding SEQ ID NO:8 or 1-100 amino acid subst or deletions or hybridizes to and

its complement, vectors, and cells comprising such and method of producing such, classified in class 536, subclass 23.1.

- XII. Claims 1, 2, 4, 5, 6, 7, 9, 10, 11-12, 14, 15, 16-17, in part, drawn to DNA encoding SEQ ID NO:10 or 85% thereof or 1-100 amino acid subst or deletions 15-266, 24-266, 32-266 of SEQ ID NO:10 or hybridizes to and its complement, vectors, and cells comprising such and method of producing such, classified in class 536, subclass 23.1.
- XIII. Claims 1, 2, 4, 6, 7, 9, 11-12, 14, 16-17, in part, drawn to DNA encoding SEQ ID NO:11 or 85% thereof or 1-100 amino acid subst or deletions or hybridizes to and its complement, vectors, and cells comprising such and method of producing such, classified in class 536, subclass 23.1.
- XIV. Claims 1, 2, 4, 5, 6, 7, 9, 10, 11-12, 14, 15, 16-17, in part, drawn to DNA encoding SEQ ID NO:12 or 85% thereof or 1-100 amino acid subst or deletions 17-259, 26-259, 34-359 of SEQ ID NO:12 or hybridizes to and its complement, vectors, and cells comprising such and method of producing such, classified in class 536, subclass 23.1.
- XV. Claims 1, 2, 4, 6, 7, 9, 11-12, 14, 16-17, in part, drawn to DNA encoding SEQ ID NO:13 or 85% thereof or 1-100 amino acid subst or deletions or hybridizes to and its complement, vectors, and cells comprising such and method of producing such, classified in class 536, subclass 23.1.
- XVI. Claims 1, 2, 4, 5, 6, 7, 9, 10, 11-12, 14, 15, 16-17, in part, drawn to DNA encoding SEQ ID NO:14 or 85% thereof or 1-100 amino acid subst or

Art Unit: 1642

deletions 19-224, 20-224, 21-224, 22-224 of SEQ ID NO:14 or hybridizes to and its complement, vectors, and cells comprising such and method of producing such, classified in class 536, subclass 23.1.

XVII. Claims 18-19, in part, drawn to a polypeptide of SEQ ID NO:8 and has 1-100 subs/deletions or 85% identical to, classified in class 530, subclass 350.

XVIII. Claims 18-20, in part, drawn to a polypeptide of SEQ ID NO:9 and has 1-100 subs/deletions or 85% identical to and residues recited in claim 20 for SEQ ID NO:9, classified in class 530, subclass 350.

XIX. Claims 18-21, in part, drawn to a polypeptide of SEQ ID NO:10 and has 1-100 subs/deletions or 85% identical to and residues recited in claim 20 for SEQ ID NO:10 and 1-60 subst/deletions or 90% to SEQ ID NO:10, classified in class 530, subclass 350.

XX. Claims 18-19, 21 in part, drawn to a polypeptide of SEQ ID NO:11 and has 1-100 subs/deletions or 85% identical to and 1-60 subst/deletions or 90% to SEQ ID NO:11, classified in class 530, subclass 350.

XXI. Claims 18-21, in part, drawn to a polypeptide of SEQ ID NO:12 and has 1-100 subs/deletions or 85% identical to and residues recited in claim 20 for SEQ ID NO:12 and 1-60 subst/deletions or 90% to SEQ ID NO:12, classified in class 530, subclass 350.

- XXII. Claims 18-19, 21 in part, drawn to a polypeptide of SEQ ID NO:13 and has 1-100 subs/deletions or 85% identical to and 1-60 subst/deletions or 90% to SEQ ID NO:13, classified in class 530, subclass 350.
- XXIII. Claims 18-21, in part, drawn to a polypeptide of SEQ ID NO:14 and has 1-100 subs/deletions or 85% identical to and residues recited in claim 20 for SEQ ID NO:14 and 1-60 subst/deletions or 90% to SEQ ID NO:14, classified in class 530, subclass 350.
2. The inventions are distinct, each from the other because of the following reasons:
- Inventions of Groups I-XXIII represent separate and distinct products which have different structures and are made by different processes. The nucleic acids of Groups I-XVI are all structurally and functionally distinct from each other because each nucleic acid has a distinct sequence and each requires a separate search in the databases. The protein of Groups XVII-XXIII are structurally and functionally distinct from each other in that each sequence is distinct and would require a different search in the databases. In addition the nucleic acids of Groups I-XVI are distinct from the polypeptides in Groups XVII-XXIII because the nucleic acids are made of nucleotides and the proteins are made up of amino acids. The polynucleotide is made by nucleic acid synthesis, while the protein is made by translation of the DNA. Furthermore, the polynucleotide can be used for hybridization screening, and the protein can be used for production of antibodies, for example The examination of all groups would require different searches in the U.S. Patent shoes and the scientific literature and would

Art Unit: 1642

require the consideration of different patentability issues. Thus the inventions I-XXIII are patentably distinct.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different classifications, restriction for examination purposes as indicated is proper.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry R. Helms, Ph.D, whose telephone number is (571) 272-0832. The examiner can normally be reached on Monday through Friday from 6:30 am to 4:00 pm, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (571) 272-0871.

6. Papers related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Fax Center telephone number is (703) 308-4242.

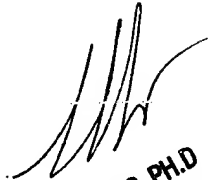
Application/Control Number: 09/976,736
Art Unit: 1642

Page 8

Respectfully,

Larry R. Helms Ph.D.

571-272-0832



LARRY R. HELMS, PH.D.
PRIMARY EXAMINER